

REMARKS

In this matter, an Advisory Action dated May 15, 2006 rejected claims 1-6 and 8-10 under 35 U.S.C. § 103 as being anticipated by Kaufman (Advisory Action, page 3). The present Request for Continued Examination has been filed to further prosecute claims 1-6 and 8-10. Thus, the instant Amendment and Response will address the rejections from the Advisory Action.

Claims 1-6 and 8-10 remain in the application. Independent claim 1 has been amended to include the limitations of the periodic acid comprising a Molarity between about 0.004M to about 0.006M. Support for this amendment can be found on page 10, paragraph 2 of the present application, for example. No new subject matter has been added with these amendments.

A. 35 U.S.C. § 103(a)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaufman in (Advisory Action, page 3). The Office contends (to which Applicants do not concede) that Kaufman teaches a range of periodic acid molarity of about 0.01, which would be obvious to be about 0.08 M as in previously presented claim 1. However, "To establish *prima facie*

obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In *re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). While Applicants do not agree that the periodic acid molarity of 0.01 is obvious to be about 0.008M as in previously presented claim 1, claim 1 has been amended to be about 0.006M. Because Kaufman does not teach or even suggest the limitation of a slurry comprising periodic acid in the range of about 0.004M to about 0.006M, as does amended claim 1, claim 1 is not rendered obvious by Kaufman. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 1 is respectfully requested.

In view of the foregoing remarks, the Applicants request allowance of the application. Please forward further communications to the address of record. If the Examiner needs to contact the below-signed Attorney to further the prosecution of the application, the contact number is (480) 715-5488.

Respectfully submitted,

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/Kathy Ortiz/
Kathy Ortiz
Reg. No. 54,351
Attorney for Applicants